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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,199	09/12/2003	Jan Prah	RW-87CONII	7201

7590 01/11/2005
Friedrich Kueffner
Suite 910
317 Madison Avenue
New York, NY 10017

EXAMINER

WIEKER, AMANDA FLYNN

ART UNIT PAPER NUMBER

3743

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/661,199

Applicant(s)

PRAHL, JAN

Examiner

Amanda F. Wieker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 September 2003 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/410,116.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to as follows:
 - Figure 4 lacks a proper label;
 - Figures 5 and 6 do not appear to show the same structure, even though the Brief Description of the Drawings (page 3) describes them as showing the same embodiment. Specifically, Figure 5 shows two slits lines that extend into the stopper but do not connect at the inner end of the lines, while Figure 6 shows two slits lines that extend into the stopper, and connect at their inner ends, to form a gap in the stopper with an open end (18).

Correction is required.

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the subject matter of claim 1 (specifically, the "swivel" about which the rails are slewably joined) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary

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to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The abstract of the disclosure is objected to because the phrase "To create" at the beginning of the abstract can be implied and should be deleted. Also, the reference to "Fig. 6" at the end of the Abstract should be deleted. Correction is required. See MPEP § 608.01(b).
4. The specification is objected to because it lacks proper section headings, such as "Background of the Invention", etc.

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.

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(1) Field of the Invention.

(2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.

(f) BRIEF SUMMARY OF THE INVENTION.

(g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).

(h) DETAILED DESCRIPTION OF THE INVENTION.

(i) CLAIM OR CLAIMS (commencing on a separate sheet).

(j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

(k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

5. The specification is objected to as follows:

- It is unclear what Applicant means by "constituted by two rails" (page 3, line 9).
It appears that Applicant means, "connected by two rails" or "including two rails" but this is not entirely clear.
- It is unclear what Applicant means by "two slits 16 are constituted with an open side 18 and opposite side walls" (page 3, lines 25-26). It appears that Applicant means, "two slits 16 form an open side 18 and opposite side walls" but this is not entirely clear.
- It is unclear to the examiner how "noise attenuation" is created by the pressing together of the slits (page 4). The specification does not adequately explain such a phenomenon.
- It is unclear what Applicant means by the "slits 16 provided for according to the invention are narrower than a Hooke's area in the expansion diagramm". It is unclear what a "Hooke's area" is. Similarly, it is not known what "expansion diagramm" is being referred to.

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- It is unclear what Applicant means by the “come to rest beforehand and cause a permanent use without wear” (page 4, lines 10-11).

6. A substitute specification without the claims is required pursuant to 37 CFR 1.125(a) because the specification is not in proper idiomatic English.

A substitute specification must not contain new matter. The substitute specification must be submitted with markings showing all the changes relative to the immediate prior version of the specification of record. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. An accompanying clean version (without markings) and a statement that the substitute specification contains no new matter must also be supplied. Numbering the paragraphs of the specification of record is not considered a change that must be shown.

Claim Suggestions

7. In claims 1-3 it is suggested that the phrases “characterized in that” be replaced with either --comprising-- or --consisting of-- to be clear whether the claim language is of open or closed form.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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9. Claim 2 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 2 recites, "the length and width of the slit (16) are dimensioned such that the slit walls (20) striking the one against the other stop a compressing of the slit (16), before a plastic deformation of the material of the rail (12) takes place." It is unclear to the examiner when the plastic deformation of the material will take place and the specification does not enable one skilled in the art to ascertain this information. Page 4 of the specification refers to a "Hooke's area" and an "expansion diagramm". Assuming that "Hooke's area" refers to "Hooke's law", it is noted that Hooke's law mathematically expresses a formula for elastic deformation, but it does not define a necessary length and width of a slit to prevent plastic deformation.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites, "two rails (12) slewably joined together at a swivel (17)". Initially, it is noted that the examiner is interpreting the term "slewably" to mean "turnably" or "rotatably", based on the standard dictionary definition of the term "slew", which is "to turn about a fixed point, usually an axis". Claim 1 is indefinite because Figures 2-4 appears to show each rail (12) connected to a plate by a swivel, not joined together as claimed.

Claim 2 recites, "the length and the width of the slit (16) are dimensioned such that the slit walls (20) striking one against the other stop a compressing of the slit (16), before a plastic deformation of the material of the rail (12) takes place". This is indefinite because the claim fails to particularly point out and distinctly claim the length and width of the slit that will not plastically deform the material. See the above discussion of the lack of enablement of the specification. Where the metes and bounds of a claim are indefinite, it is improper to base a rejection on speculation as to the meaning of the claim. In re Steele, 305 F.2d 858, 134 USPQ 292 (CCPA 1962). Specifically, unclear claims are indefinite, not obvious. In re Wilson, 424 F.2d 1382, 185 USPQ 494 (CCPA 1970).

Claim 3 is rejected because of its dependency on claims 1 or 2.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Number 5,409,449 to Nebolon.

Nebolon discloses a knee orthosis comprising two rails (22, 24; see Figures 1-3b) slewably joined together (78) at a swivel, one of the rails having a stopper (32), one of the rails having a slit (see Figures 3a-3c) adjacent the stopper with an open side and opposite slit walls which when the rails strike each other at an extended position, the walls move toward each other by elastically deforming.

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14. Claim 3 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nebolon in view of U.S. Patent Number 5,292,303 to Bastyr.

Nebolon discloses in column 5, lines 14-17 that the construction of the device is incorporated by reference to Bastyr. Bastyr discloses in column 4, lines 63-67 that the brace is made of lightweight, but high-strength material, such as titanium or steel. In the alternative, one of ordinary skill in the art would have provided the metallic material of the Nebolon device with titanium or steel, as taught by Bastyr, in order to make the device both lightweight and high-strength.

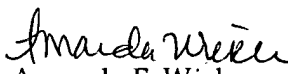
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amanda F. Wieker whose telephone number is 571-272-4794. The examiner can normally be reached on Monday-Thursday, 8:30 - 6:00 and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on 571-272-4791. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Henry Bennett
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Examiner

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